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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,437

11/12/2003

Victor Paul Holbert

IP-023587

7149

1726

7590

05/03/2006

INTERNATIONAL PAPER COMPANY
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LOVELAND, OH 45140

EXAMINER

PATTERSON, MARC A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,437

Applicant(s)

HOLBERT ET AL.

Examiner

Marc A. Patterson

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

REPEATED REJECTIONS

1. The 35 U.S.C. 103(a) rejection of Claims 1 – 3, 6, 9 – 14, 16 and 18 – 19 as being unpatentable over Kiang (U.S. Patent No. 5,370,941), of record on page 2 of the previous Action, is repeated.

2. The 35 U.S.C. 103(a) rejection of Claim 4 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Lorence (U.S. Patent No. 5,818,016), of record on page 5 of the previous Action, is repeated.

3. The 35 U.S.C. 103(a) rejection of Claims 5 and 15 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Shanton (U.S. Patent No. 6,066,375), of record on page 5 of the previous Action, is repeated.

4. The 35 U.S.C. 103(a) rejection of Claims 7 and 17 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Bissot (U.S. Patent No. 4,818,782), of record on page 6 of the previous Action, is repeated.

5. The 35 U.S.C. 103(a) rejection of Claim 8 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Adur (U.S. Patent No. 5,942,295), of record on page 7 of the previous Action, is repeated.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of Claims 1 – 3, 6, 9 – 14, 16 and 18 – 19 as being unpatentable over Kiang (U.S. Patent No. 5,370,941), 35 U.S.C. 103(a) rejection of Claim 4 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Lorence (U.S. Patent No. 5,818,016), 35 U.S.C. 103(a) rejection of Claims 5 and 15 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Shanton (U.S. Patent No. 6,066,375), 35 U.S.C. 103(a) rejection of Claims 7 and 17 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Bissot (U.S. Patent No. 4,818,782), and 35 U.S.C. 103(a) rejection of Claim 8 as being unpatentable over Kiang (U.S. Patent No. 5,370,941) in view of Adur (U.S. Patent No. 5,942,295), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 5 of the remarks dated February 17, 2006, that Kiang discloses a food contact surface comprising only PMP.

However, as stated on page 2 of the previous Action, Kiang discloses that the polymethylpentene comprises a polymethylpentene homopolymer or copolymer, and that the disclosed copolymer is a copolymer of polymethylpentene with propylene and is therefore a polypropylene; it would have been obvious for one of ordinary skill in the art to have selected a blend of polymethylpentene homopolymer and polymethylpentene / propylene copolymer.

Applicant also argues, on page 7, that there is no motivation for a blend of polymethylpentene homopolymer and polymethylpentene / propylene copolymer,

Art Unit: 1772

because Kiang discloses a blend of polymethylpentene homopolymer and copolymer as an adhesive; therefore, Applicant argues, there is not a reasonable expectation of success.

However, as stated above, Kiang also clearly discloses polymethylpentene homopolymer and copolymer with propylene as polymers for use in the food contact layer.

Applicant also argues, on page 7, that the blend would be recognized by one of ordinary skill in the art to have a different surface tension than the claimed surface tension.

However, as stated on page 3 of the previous Action, it is unclear why the surface tension would differ, because both polymethylpentene and polypropylene have the claimed surface tension.

Applicant also argues, on page 7, that the rejection of dependent Claim 4 is inappropriate for the reasons stated above. In response, the answers above are repeated.

Applicant also argues, on page 8, that the rejection of dependent Claims 5 and 7 is inappropriate for the reasons stated above. In response, the answers above are repeated.

Applicant also argues, on page 9, that the rejection of dependent Claim 8 is inappropriate for the reasons stated above. In response, the answers above are repeated.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 1772

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Patterson 5/1/06
Marc A. Patterson, PhD.
Primary Examiner
Art Unit 1772